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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,699	11/10/2003	John W. Devauli	247079-000090USP1	5232
70001	7590	01/02/2008		
NIXON PEABODY, LLP 161 N. CLARK ST. 48TH FLOOR CHICAGO, IL 60601-3213			EXAMINER SAGER, MARK ALAN	
			ART UNIT 3714	PAPER NUMBER
			MAIL DATE 01/02/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/705,699

Applicant(s)

DEVAULL ET AL.

Examiner

M. A. Sager

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date Oct 15, 2007.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

*Terminal Disclaimer*

1. The terminal disclaimer filed on Oct 15, 2007 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of full statutory term of patent 6739971 has been reviewed and is accepted. The terminal disclaimer has been recorded.

*Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claim 1, 8-9 and 16 is rejected under 35 U.S.C. 102(b) as being anticipated by Falciglia (5935002). Falciglia discloses a gaming machine and method including a gaming terminal (3:1-4:28, ref. 1), an input device (5, 11, 13), a wager input device for receiving a wager from player to play the game (9), a processor (8:10-19:12, figs 1-8, esp. fig. 5 and 8, ref.132, 196) for accumulating bonus points based on predetermined criteria and allowing player to redeem a number of bonus points for an award at a time selected by player such as during any game play cycle (5:41-48).

4. Claim 1-4, 8-12 and 16 is rejected under 35 U.S.C. 102(e) as being anticipated by Baerlocher (6726563). Baerlocher discloses a method and gaming machine (figs 1-8) teaching

claimed steps/features including a value input device for receiving a wager (3:59-4:7), a processor for accumulating bonus points based on predetermined criteria and allowing the player to redeem a number of bonus points for an award at a time selected by the player such as during any game play cycle (2:10-3:10, 4:48-5:35, 5:60-11:36, fig 108, ref 40) wherein the player may redeem for one of a plurality of player selectable options (2:20-3:10, fig 1-8), wherein the plurality of possible options include a plurality of bonus game features worth different numbers of bonus points and wherein the game features are interactive as a plurality of player-selectable elements (2:20-3:10, figs 1-8, esp. fig 3-8, ref 34, 62, 64, 66, 68, 70, 72, 108, 110, 112, 114, 116, 118, 120, 122, 124, 126).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 5-7, and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baerlocher ('563) in view of either Acres ('125) or Kelly ('918) or Wain (EP 281402).

Alternatively, where Baerlocher '563 redeems accumulated points for a credit amount (various award values shown in figs. 3, 5-8) as a bonus, Baerlocher discloses claimed steps/features including a plurality of player selectable elements as key holes that provide a random credit amount but, as best understood, appears to lack either a bonus game feature or a fixed credit amount. However, it is notoriously well known in gaming to allow a player to redeem points for a bonus game feature such as a free game/spin that is a fixed credit amount or a number of 'hold' or 'nudge' steps. Acres (12:65-13:8, 14:25-37 and 54-59) or Kelly (3:13-16, 22-23, 7:33-39, 8:25-28, 21:59-61, 27:47-50) each disclose a gaming machine and method teaching accumulating points that may be redeemed for a free game/spin that is a fixed credit amount. While Acres accumulated points relate to patron or loyalty points won/earned based on play of game, Kelly accumulated points relate to points won based on performance or outcome of game play, but each suggests converting earn/won points to a fixed credit amount such as for a free game/spin that has an equivalent fixed cash or credit value such that in each Acres and Kelly player elects to redeem points such as by converting to credit amount during any play. Also, Wain discloses a method where a player may elect to accept either a prize value after accumulating (1:31-40) where the prize value is either a value of coins [implicit, fixed], or a game feature such as hold or nudge step (2:43-47). The accumulation in Wain is either steps of ladder/path or letters to form a word where player elects when to stop and redeem during any play. A free game/spin may also be a bonus game feature such as taught by Acres or Kelly. All of the component parts are known in Baerlocher, Acres, Kelly and Wain. The only difference is the combination of 'old elements' into a single device by allowing a player to select among a plurality of options that include a fixed credit amount or a bonus game feature; however, as

shown, Baerlocher allows a player to select among a plurality options of multiple features; while, Acres, Kelly or Wain each allow a player to select a fixed credit amount or a bonus game feature such as hold or nudge or free game. Thus, in further consideration of Supreme Court decision in KSR International Co v Teleflex Inc., it would have been obvious to an artisan at a time prior to the invention to add fixed credit amount or bonus game feature as known or as taught by either Acres or Kelly or Wain to gaming machine and method of Baerlocher to achieve predictable results of allowing player option to select redeem points won/earned. It is noted that the pricing of awarding points converted is also taught. Finally, breadth of claim language 'bonus points', accumulating bonus points and redeem bonus point includes and does not preclude points won or earned as taught/suggested by either Baerlocher as combined with either Acres or Kelly or Wain.

#### ***Response to Arguments***

8. Applicant's arguments with respect to claims 1-16 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

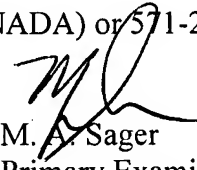
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. A. Sager whose telephone number is 571-272-4454. The examiner can normally be reached on T-F, 0700-1730 hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on 571-272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



M. A. Sager  
Primary Examiner  
Art Unit 3714

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